

REMARKS

Claims 1-21 are currently pending in the subject application, and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

**I. Rejection of Claims 1, 2, 4, 5, 10, 11, 13, 14, 19, and 20 Under 35 U.S.C. §102(b)**

Claims 1, 2, 4, 5, 10, 11, 13, 14, 19, and 20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Piber (U.S. Pat. 4,082,934). It is respectfully requested that this rejection be withdrawn for at least the following reasons.

In the 'Response to Arguments' section of the Office Action dated November 6, 2001, Examiner states "Piber teaches at least one elongated strip of substantially translucent material 34c extending through the first side and at least one of the second and third side so that part of the strip is visible at the first side (figure 4, col. 3, lines 61-61). Further, Piber teaches the second side 34e is also visible as shown in figure 4, col. 4, lines 9-14." However, claim 1 recites:

a housing having *a first side extending generally between second and third sides*; and

at least one elongated strip of substantially translucent material *extending through the first side and at least one of the second and third sides* so that part of the strip is *visible at the first side and the at least one of the second and third sides*.  
(emphasis added)

Thus, in claim 1, the strip of substantially translucent material is visible at a first side and at least one of a second and third side of a housing *through which the strip extends*. Although, Piber discloses a light transmitting insert (See, Figs. 4 and 5) located at and extending into a first side of a handle so that part of the strip is visible at the first side, Piber does not disclose the strip of translucent material *extending through a second or third side* so that part of the strip is visible at the second or third side. Instead, the insert simply extends into a flattened tunnel (or slot) formed in the handle.

Further, Examiner argues "Piber teaches the second side 34e is also visible". However, Applicant respectfully submits that Examiner is merely showing that a second side of the translucent strip (34e) is visible. Piber does not teach the strip of substantially translucent material *extending through a second side of the housing* such that the strip is visible at the second side of the housing. In contrast, Piber teaches that the insert *extends into a single end* of a flattened tunnel, which extends longitudinally vertically through an operating handle (Figs. 2 and 4).

To anticipate a claim, the reference must set forth *each and every element* in the claim either expressly or inherently. Thus, because Piber does not disclose a strip of substantially translucent material extending through at least one of a second and third side of a housing such that the strip is visible at the least one of a second and third side of the housing, Piber does not anticipate claim 1 or claims 2, 4, 5, and 10, which depend therefrom. Accordingly, withdrawal of this rejection is respectfully requested.

Regarding claim 11, it is respectfully submitted that Piber does not disclose an elongated slot formed in a housing extending through the first and at least one of the second and third sides of the housing, *the first side of the housing extending between the second and third sides*. Although Piber teaches a tunnel formed within an operating handle, the first side of the handle through which the tunnel extends is *directly opposite and spaced apart from* the second side through which the tunnel extends, and thus, the first side into cannot be considered to extend between the second side and another side of a housing, as recited in claim 11. Furthermore, the insert is not visible at both sides of the tunnel, since one side of the insert (34d) is disposed within the interior of the handle so as not to be visible. Thus, since Piber does not set forth each and every element of claim 11, Piber does not anticipate claim 11. Accordingly, withdrawal of this rejection and allowance of claim 11 and claims 13, 14, and 19, which depend therefrom, are respectfully requested.

Claim 20 recites that the translucent means extends through a plurality of sides of a sidewall of housing means. Piber does not teach or suggest a substantially translucent means extending through a plurality of sides of the sidewall portion of the housing means, as recited in amended claim 20, similar to the reasons stated above with respect to claims 1 and 11.

For these reasons, withdrawal of this rejection and allowance of independent claims 1, 11, and 20 and their dependent claims 2, 4, 5, 10, 13, 14, and 19 are respectfully requested.

## **II. Rejection of Claims 3, 6-9, 12, and 15-18 Under 35 U.S.C. §103(a)**

Claims 3, 6-9, 12, and 15-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Piber in view of Duerkob (U.S. Pat. 4,954,808). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claims 3, 6-9 and 12, and 15-18 directly or indirectly depend from independent claims 1 and 11, respectively. Duerkob does not make up for the aforementioned deficiencies of Piber with respect

to claims 1 and 11. Therefore, claims 3, 6-9, 12, and 15-18 are not obvious over the combination of Piber and Duerkob.

Moreover, to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to create the claimed subject matter. Piber is directed to illuminated electric switches having a pivotal operating handle, such as tab switches, toggle lever switches, rocker switches, etc, while Duerkob is directed to a lighted turn and stop signal for rear mounted, eye level use on an inside shelf of an automobile. Thus, Piber and Duerkob cannot be combined to make the present invention obvious because there is not proper motivation or would one skilled in the art be otherwise motivated to combine the reference teachings.

Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the cited art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Piber does not teach or suggest the light source having an illuminated condition and non-illuminated condition, each condition being indicative of an operating condition of the indicator apparatus, as recited in claim 3, nor does it refer to any problem that would suggest to one of ordinary skill in the art to use such an indicator.

Likewise, Piber does not refer to or suggest any problem that would suggest to one of ordinary skill in the art to use a substantially opaque material as a partition to separate at least two elongated strips of substantially translucent material, as recited in claim 6, nor to include a different light source operatively associated with each of the at least two elongated strips so that light from each source illuminates a corresponding one of the at least two elongated strips, as recited in claim 7. It is respectfully submitted, that the suggested combination to employ a substantially opaque partition between strips of translucent material, as recited in claims 6 and 7 appears to be based on improper hindsight, in which the present application provides the teaching and motivation to do so. For example, why would one of ordinary skill in the art desire to employ more than one lighted end cap in a switch (according to Piber), which are separated by partitions (according to Duerkob)? Neither Piber nor Duerkob contain a teaching or suggestion that would provide proper motivation to combine the teachings to create the subject matter of claim 6 or claim 7, which depends from claim 6.

Furthermore, to prevent the use of hindsight based on the invention to defeat patentability of the invention, the courts require the examiner to show a motivation to combine the references that

create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2D 1453 (Fed. Cir. 1998). Applicant submits there is not proper motivation to make such a combination.

Further still, it is apparent that Examiner merely recited the same arguments from a previous Office Action, dated July 18, 2001 to support this rejection. Under §2142 of the MPEP:

When an applicant submits evidence, whether in the specification as originally filed or in reply to a rejection, the examiner must reconsider the patentability of the claimed invention. The decision of patentability must be made based upon consideration of all the evidence, including the evidence submitted by the examiner and evidence submitted by the applicant. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence.

However, in maintaining this rejection, Examiner does not show that Applicant's arguments in the Reply to Office Action Dated July 18, 2001 relating to claims 3, 6-9, 12 and 15-18 were ever considered, as particular arguments presented appear to have been ignored in the Examiner's response.

Accordingly, withdrawal of this rejection and allowance of claims 3, 6-9, 12, and 15-18 are respectfully requested.

### **III. Rejection of Claim 21 Under 35 U.S.C. §103(a)**

Claim 21 stands rejected under 35 U.S.C. as being unpatentable over Piber in view of Schneider *et al.* (U.S. Pat. Des. 391,182). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Piber and Schneider *et al.* cannot be combined to make claim 21 obvious because there is not proper motivation to combine the reference teachings. Piber is directed to illuminated electric switches and the problems associated with such switches, such as the intensity of the illumination, the difficulties of relamping, and interchangeability of the operating handle. Thus, Piber does not refer to any problem that would suggest to one of ordinary skill in the art to use a proximity switch in combination with the illuminated electric switch of Piber. Likewise, the teachings of Piber would not suggest to one of ordinary skill in the art to use a proximity switch in combination with the

illuminated electric switch, as taught in Piber.

Again, Examiner does not provide any reason that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited references for combination in the manner claimed. Nor does Examiner show that Applicant's arguments in favor of claim 21 in the Reply to Office Action Dated July 18, 2001 were ever considered.

Accordingly, withdrawal of this rejection and allowance of claim 21 are respectfully requested.

#### IV. Conclusion

The present application is believed to be condition for allowance in view of the above comments.

If any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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